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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,826	01/03/2002	Benjamin R. Yerxa	03678.0023.CNUS03	5357
27194	7590 06/11/2003			
HOWREY SIMON ARNOLD & WHITE, LLP			EXAMINER	
BOX 34		YOUNG, JOSEPHINE		
	WOOD AVE.	YOUNG, JC	SEPHINE	
MENLO PAR	K, CA 94025	•	ART UNIT	PAPER NUMBER
			1623	
			DATE MAILED: 06/11/2003	
	·	•		5

Please find below and/or attached an Office communication concerning this application or proceeding.

- i		Application No.	Applicant(s)			
Office Action Summary		10/041,826	YERXA ET AL.			
		Examiner	Art Unit			
		Josephine Young	1623			
Period fo	The MAILING DATE of this communication app ars on the cov r she t with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status						
1)	Responsive to communication(s) filed on					
2a)□		s action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
Disposit	ion of Claims		.,,			
4)⊠ Claim(s) <u>1-15</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5)□	5) Claim(s) is/are allowed.					
6)□	6)☐ Claim(s) is/are rejected.					
7)	Claim(s) is/are objected to.		,			
•	Claim(s) <u>1-15</u> are subject to restriction and/or e	election requirement.				
Application Papers						
9)☐ The specification is objected to by the Examiner.						
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.						
12) The oath or declaration is objected to by the Examiner.						
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
,—	☐ All b)☐ Some * c)☐ None of:	priority under to o.e.o. 3	(0) (0)			
۵,	1. Certified copies of the priority documents	s have been received.				
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).						
 a) ☐ The translation of the foreign language provisional application has been received. 15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. 						
Attachment(s)						
2) Notic	ce of References Cited (PTO-892) ce of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Inf	ormal Patent Application (PTO-152)			

U.S. Patent and Trademark Office PTO-326 (Rev. 04-01)

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to methods of enhancing drainage of the lachrymal system using a mononucleotide compound of Formula I, III or IV, classified in class 514, subclasses 45⁺, 48, 49⁺, 51, 52.
- II. Claims 1-15, drawn to methods of enhancing drainage of the lachrymal system using a dinucleotide compound of Formula II, including P¹,P⁴-di(uridine-5')-tetraphosphate, classified in class 514, subclasses 44, 45⁺, 48, 49⁺, 51, 52.

Claims 1-14 link Groups I and II and will be examined together with the Group that is elected as it pertains to the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to methods using compounds with patentably distinct functional groups. The method of Group I is directed to the use of mononucleotide compounds, which is patentably distinct from methods using dinucleotide compounds, as per Group II. The methods of one do not render obvious the methods of another.

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Because these inventions are distinct for the reasons given above and have acquired a

separate status in the art as shown by their recognized divergent subject matter, restriction for

examination purposes as indicated is proper. A reference for one group could not reasonably be

expected to be a reference for the other. Further, searching both of the inventions constitutes a

burdensome search, as a thorough search comprises a search of foreign patents and non-patent

literature, as well as the appropriate U.S. patent classifications. To search the two independent

and distinct inventions, set forth supra, would indeed impose an undue burden upon the examiner

in charge of this application.

Applicant is advised that the reply to this requirement to be complete must include an

election of the invention to be examined even if the requirement is traversed (37 CFR 1.143).

Election of Species

If Group II is elected, Applicant is required under 35 U.S.C. 121 to elect a single

disclosed species for prosecution on the merits to which the claims shall be restricted if no

generic claim is finally held to be allowable. Currently, the claims are generic to a plurality of

disclosed patentably distinct species such that each species is directed to a method for

stimulating tear secretion and mucin production in eyes using a dinucleotide compound of

Formula II, wherein

• X is one of the following distinct moieties: an oxygen, a carbon based moiety or a

nitrogen based moiety;

• the sum of m+n is 0, 1, or 2;

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AND

B and B' are each independently either a purine of general formula IIa or a pyrimidine of

general formula IIb.

Applicant is advised that a reply to this requirement must include an identification of the

species that is elected consonant with this requirement, and a listing of all claims readable

thereon, including any claims subsequently added. An argument that a claim is allowable or that

all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of

claims to additional species which are written in dependent form or otherwise include all the

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

the election, applicant must indicate which are readable upon the elected species. MPEP §

809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct,

applicant should submit evidence or identify such evidence now of record showing the species to

be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission

may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josephine Young whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (703) 308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

JY June 5, 2003

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